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REMARKS

This response is to the Office Letter mailed in the above-referenced case on April 11, 2006. Claims 1-21, 23 and 26-34 are standing for examination. The Examiner has rejected claims 1-2, 8, 12-14 and 23-28 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,948,061 ("Merriam") in view of U.S. Patent No. 6,836,799 ("Philyaw"). Claims 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rakavy in view of Middleton. Applicant believes the Examiner erred in this statement as his rationale in the rejection relies upon the art of Philyaw. For the purpose of the present response, applicant will interpret the rejection as relying upon Philyaw, not Middleton.

Claims 3 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view Philyaw and further in view of U.S. Patent No. 6,651,190 ("Worley"). Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view Philyaw and further in view of U.S. Patent No. 5,933,811 ("Angles"). Claims 9 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view of Philyaw and further in view of Ravashetti (US 6,230,199) hereinafter Ravashetti. Claims 10-11 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view of Philyaw and further in view of U.S. Patent No. 6,665,715 ("Hour"). Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriam in view Philyaw and further in view of Rakavy.

Applicant has again carefully studied the prior art presented by the Examiner, and has reviewed the Examiner's rejections, references and comments. Applicant herein argues the patentability of the claims, as amended, over the prior art newly presented by the Examiner. No amendments are made to the claims.

Applicant points out that this is the fifth action, and yet again, the Examiner has brought new grounds of rejection relying on new art that still fails to teach applicant's invention. Applicant feels that the present rejection under "new grounds" is excessive

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and puts an unfair burden on Applicant's right to a U.S. Patent. Applicant for the record wishes to mention as well that this is a practice that has suddenly (in the past few months) gained a lot of traction in the USPTO. The undersigned agent is receiving an unprecedented number of actions after several rounds of prosecution in which the Examiner simply tosses out all of the prosecution history, causes another search to be done, and just starts over with new rejections. The undersigned is pretty sure that a large number of Examiners did not independently hit on this as a good course of action. It must be a policy, and if so, it is going to draw some serious legal challenge at some point. This places a serious burden on the Office as well as the agent or attorney, and infringes on the rights of the applicant.

Regarding claims 1, 15 and 23, in the present Action the Examiner states that Merriman fails to specifically disclose an instance of software residing on the first server for recording any user activity data routed through the first server including at least transaction activity occurring at any destination websites the user freely chooses to navigate to. The Examiner now relies on the reference of Philyaw to teach this deficiency in the new grounds for rejection.

The Examiner contends that Philyaw teaches a tracking software residing on a user PC (i.e. first server) for tracking (recording) any data-packet-network activity of the user (see abstract and Col. 3 lines 16-26) including, at least, transaction activity occurring at any web site servers on a global communication network (Internet or the World Wide Web) the user freely chooses to navigate to (see FIG. 25-26 and Col. 26 lines 1-56) for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the network activity tracking of Philyaw with the system of Merriman because it would provide for the purpose of tracking the user's efforts and interests as he or she visits the various web sites on the global communication network (see Col. 25 lines 47-51).

Applicant argues that the Examiner has neglected to acknowledge the clear teaching of Philyaw (emphasis added) wherein a user PC (302) disposed on a network

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(306) runs tracking software which initially requires registration to a registration server (2500). The registration process is initiated by the user entering user information into the tracking software for transmission to the registration server (2500). In response to registration, the registration server (2500) sends a unique ID and bar code back to the user PC (302). Subsequently, when the user accesses a vendor server (2504) disposed on the network (306), the user PC (302) passes the unique ID/bar code to the vendor server (2504). The vendor server (2504) sends the unique ID/bar code to the registration server to obtain user profile information which matches the unique ID bar code. As the user accesses the vendor server (2504), the user activities are logged and returned to the registration server (2500) for updating the user information stored therein. Alternatively, the user information is stored (Abstract).

Clearly, Philyaw is not capable of providing an instance of software residing on the first server capable of recording any user data-packet-network navigation activity data routed through the first server including, at least, transaction activity occurring at any destination Web sites the user freely chooses to navigate to. Philyaw is restricted to vendor Web sites capable of accepting the proprietary bar codes and IDs of the user. Applicant asserts this inherently provides for server partnering with the tracking software prior to the user navigation activities.

Applicant's invention teaches and claims recording actual transactions at any Web sites freely navigated to and visited by the user. Applicant stresses that the user's activity can be tracked no matter where the user navigates to, even to un-partnered servers. Online behavior of the user is compiled using the user-activity and server-activity data, which is collected and analyze in order to compile an all inclusive online behavior profile, and it is the stored and constantly updated online behavior profile of the user that determines the targeting of the advertisements.

Applicant believes that claims 1, 15 and 23, as amended, are clearly patentable over the art presented by the Examiner, either singly or in combination. Claims 2-14, 16-21, and 26-34 are patentable on their own merits, or at least as depended from a patentable claim.

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It is therefore respectfully requested that this application be reconsidered, the claims be allowed, and that this case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this amendment, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

Respectfully Submitted,
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